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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/759,851 | 01/16/2004 | Hitoshi Shirasaka | HOKUSHIN-3II | 8739 |
| 26939 | 7590 | 12/19/2005 | EXAMINER | |
| HUNTLEY & ASSOCIATES 1105 NORTH MARKET STREET P.O. BOX 948 WILMINGTON, DE 19899-0948 | | | SERGEANT, RABON A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,851

Applicant(s)

SHIRASAKA, HITOSHI

Examiner

Rabon Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/011,303.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/16/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. It is requested that applicant amends the continuing data to reflect the current status of the parent application.
2. Applicant's foreign patent documents EPO 01128923, JP 63-154722, and JP 9-208820 have not been considered, because EPO 01128923 does not appear to be a foreign patent document and the Japanese references have not been provided in accordance with 37 CFR 1.98(a)(2)(i). The supplied abstracts for the Japanese references have been cited on Form PTO-892.
3. Claims 1-6, 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, within claim 1, it is unclear what operations and "kinds" are encompassed by the language, "selecting the kinds and blend proportion ...". Furthermore, since the definition of "kinds" is unclear, the position is taken that the language so extends the scope of the reactants, that the claims are rendered indefinite.

Secondly, within claims 3, 5, 9, and 11, there is a word omission after "essentially".

4. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has failed to adequately disclose how the claimed ester group and urethane group concentrations are determined or measured.

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5. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has failed to provide an enabling disclosure, because applicant failed to teach one how the ester group and urethane group concentrations are determined or measured. Furthermore, since applicant has failed to clearly teach how to determine the aforementioned group concentrations, it follows that applicant has additionally failed to teach how to determine the necessary proportion of reactants. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

6. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for urethane compositions derived from the reactants disclosed at page 4, line 16 through page 5, line 8 of the specification, does not reasonably provide enablement for urethane compositions derived from virtually any polyester diol and diisocyanate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant has failed to provide adequate enablement for the production of urethanes having the claimed properties which are produced from other than the aforementioned reactants. Applicant's specification provides insufficient guidance with respect to the selection of other suitable reactants that will yield the claimed and disclosed properties of the invention. In accordance with this position, applicant has failed to provide enablement commensurate in scope

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with the claimed process step, "selecting the kinds and blend proportion ...". *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 783009.

The reference discloses millable, crosslinked polyurethanes, suitable for producing molded articles, which have excellent hydrolysis resistance and physical properties, produced from the reaction of poly(ϵ -caprolactone) diols and polyisocyanates that meet those of applicant. Furthermore, the polyurethanes have applicant's claimed hardness values and glass transition values. See examples 2 and 3 within the reference, for example. Though the reference is silent with respect to the polyurethanes being resistant to oils and the concentrations of ester and urethane groups, the position is taken, in view of the aforementioned disclosed features, that these properties are inherent features of the claimed elastomers. Regarding claims 7-12, though the reference fails to specifically recite an oil-seal member, the position is taken that without further claimed structure governing the oil-seal member, the disclosed molded articles are sufficient to meet the claims. The inherently possessed properties of the disclosed polyurethane articles enable them to function as oil-seals.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
December 11, 2005


RABON SERGENT
PRIMARY EXAMINER